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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,432	09/25/2003	Jerome Blondeau	L7307.03159	4252

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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
	3736

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/669,432 Examiner Jeffrey G. Hoekstra	BLONDEAU, JEROME Art Unit 3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 April 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) 5 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

1. In response to the amendment filed on 04/04/2006, amended claims 1-13, new claim 14, and amendments to the specification are acknowledged. The current rejections of the claims 1-13 are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Claim Objections

2. Claim 5 is objected to because of the following informalities:
3. The positive recitation of "said other slide" and "said one slide" appears to lack insufficient antecedent basis for this limitation in the claim and renders the claim indefinite and/or unclear.
4. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bauer.

7. For claim 1, Bauer discloses a surgical biopsy device, comprising:

- (a) a needle 68 with a recess about the distal end for receiving biopsy sample, as best seen in Figure 1B;
- (b) a cannula 80 coaxially disposed around said needle and able to slide independently of said needle;
- (c) slides 31,33 connected to said cannula and needle and comprising transversely offset limit stops 69;
- (d) springs 45,64 connected to said slides;
- (e) an elongated housing 1a, 1b for gripping defining an inner volume within which said slides and associated needle/cannula traverse from distal to proximal positions;
- (f) a control button 32 for traversing said slides to a proximal position one after another thus contracting said springs and comprising a lug 53 that moves along with button displacement and acts upon limit stops to bring slides to said proximal position;
- (g) a means for blocking 42,62 said slides in a proximal position; and

- (h) a trigger mechanism 10,11 that cancels said blocking means and causes sequential forward displacement of said slides associated with needle/cannula via said springs elasticity (column 6 lines 37-65).

8. For claims 2 and 3, Bauer discloses a displacement means comprising a spring 55 connected to said control button and said lug that permits said cannula/slide to spring into a distal position and wherein an inclined ramp 31a terminating in a lateral edge returns said lug from a deployed position to a retracted one when the slide-cannula combination is located in a distal position, as best seen in Figure 8. Bauer discloses said lug compressing said spring 55 and situated at the same level as said limit stop 69 of first displaces cannula/slide.

9. For claim 4, Bauer discloses a slidably connected 51a, 51b relationship between said lug and said control button as best seen in Figure 1A.

10. For claims 5 and 14, Bauer discloses said slide/cannula/spring first situated distally, then proximally displaced via said lug, while said slide/needle/spring are proximally displaced subsequently (column 5 lines 26 – column 6 lines 21 and column 6 lines 37-65).

11. For claim 6, Bauer discloses an oblong opening 9 for said control button to slide through, as best seen in Figure 1A, and a spring 70 that returns said control button to its initial distal position located at the front of said opening.

12. For claim 7, Bauer discloses a blocking means comprises a hooking/releasing device comprising elastically deformable hooks and fixed limit stops that engage when

the cannula/slide and/or needle/slide are displaced in the proximal direction as best seen in Figure 12C (column 2 lines 34-42).

13. For claim 8, Bauer discloses triggering mechanisms including front and rear tumblers 17,19 able to be actuated independently.
14. For claim 9, Bauer discloses front 17 and rear 19 tumblers connected.
15. For claim 10, Bauer discloses a pushbutton 11 with an elastic member 41 with a bracket projecting into housing to free blocking means; moreover, the slide/needle is configured with an unblocking bracket 18 projecting to act on blocking means, as best seen in Figure 12D.
16. For claim 11, front tumbler 17 comprises a lever pivoting about an axis wherein said connection connects lever and rear tumbler, as best seen in Figure 12C.
17. For claim 12, Bauer discloses a notch safety means (column 1 lines 54-62) for rendering trigger mechanism inoperative.
18. For claim 13, Bauer discloses a housing comprised of two half-shells 1a, 1b joined together.

Response to Arguments

19. Applicant's arguments filed 04/04/2006 have been fully considered but they are not persuasive. Applicant argues Bauer fails to disclose each and every aspect of the invention.
20. In response to applicant's argument that Bauer fails to disclose "a control button that acts to bring two slides sequentially, one after the other, to a rearward position of a sampling device", a recitation of the intended use of the claimed invention must result in

a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

21. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "...two sliders are arranged in series and are actuated by only one control button, which provides sequential charging of a needle and a cannula..." and "...the claimed device automatically fires both the charged needle and cannula upon the actuation of either one of two tumblers...") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

22. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Avaltroni (US 5,989,197) and Cooke et al (US 2004/0097830 A1). Both disclose automated biopsy needle devices with coaxially disposed cannula and needle structures.

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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